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CLIENT NO.: PHIL06-00377

PATENT

#14
3/16/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Carolyn Ramsey Catan

Serial No.:

09/734,808

Filed:

December 12, 2000

For:

REMOTE CONTROL ACCOUNT AUTHORIZATION
SYSTEM

Group No.:

3624

Examiner:

A. L. Bashore

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF

The Appellants have appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner dated October 8, 2003, finally rejecting Claims 5-11 and 13-16. The Appellants filed a Notice of Appeal on January 5, 2004. The Appellants respectfully submit this brief on appeal, in triplicate, with a statutory fee of \$330.00.

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REAL PARTY IN INTEREST

This application is currently owned by Philips Electronics North America Corporation, as indicated by an assignment recorded on December 12, 2000 in the Assignment Records of the United States Patent and Trademark Office at Reel 011373, Frame 0857.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-4, 12 and 17 have been canceled from the above-identified patent application. Claims 5-11 and 13-16 remain pending in the above-identified patent application. Claims 5-11 and 13-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,845,260 to Nakano et al. ("*Nakano*") in view of U.S. Patent No. 5,721,583 to Harada et al. ("*Harada*"). Claims 5-11 and 13-16 are presented for appeal. Claims 5-11 and 13-16 are shown in Appendix A.

STATUS OF AMENDMENTS

The Appellants submitted an AMENDMENT AND RESPONSE UNDER 37 C.F.R. §1.116 on November 19, 2003. The AMENDMENT AND RESPONSE amended the specification to correct a typographical error. No claims were amended. The Examiner refused to enter the amendment, asserting that the proposed amendment to the specification failed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

SUMMARY OF INVENTION

According to one embodiment, a consumer electronics device 50, shown in Figure 4, is provided with a memory that stores account information for an account holder and sub-credit limits and bioauthentication information for authorized users of the account. (*Application, Page 7, Lines 11-13; Page 8, Lines 3-19*). The device further includes a bioauthentication device that provides bioauthentication information to the memory and a processor that compares received bioauthentication information to stored bioauthentication information to detect a match. (*Application, Page 9, Lines 6-11*). The processor further finds an associated sub-credit limit corresponding to the received bioauthentication information to enable a purchase over the response network via the communication network up to a maximum of the sub-credit limit. (*Application, Page 9, Lines 11-16*). The processor sends the account holder information over a communication link only if the match is detected and the sub-credit limit is not exceeded. (*Application, Page 9, Lines 11-16*).

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STATEMENT OF ISSUES

Whether Claims 5-11 and 13-16 are unpatentable under 35 U.S.C. 103(a) over *Nakano* in view of *Harada*.

GROUPING OF CLAIMS

Pursuant to 37 C.F.R. § 1.192(c)(7), the Appellants request that Claims 5-11 and 13-16 be grouped together for purposes of this appeal.

ARGUMENT

The rejection of Claims 5-11 and 13-16 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

A. OVERVIEW

Claims 5-11 and 13-16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,845,260 to Nakano et al. (“*Nakano*”) in view of U.S. Patent No. 5,721,583 to Harada et al. (“*Harada*”).

B. STANDARD

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability of a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness

is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed.Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching

or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”). *In re Rouffett*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”)

C. THE NAKANO REFERENCE

Nakano recites a charging system for a parent to control spending by a child. The parent sets an imaginary account 2, shown in Figure 1 and Figure 3, for the child in a remote server/processor 1 of the service provider company. (*Col. 3, Lines 1-9 and Lines 51-55*). When the child selects a desired service on a display device 4, a charge request is sent over a communications link to the remote server/processor 1 via a set-top box 3. (*Col. 3, Lines 11-15*). The charge request includes the child’s identification data. (*Col. 3, Lines 15-17*). The remotely located server/processor 1 makes a

determination whether the balance in the imaginary account 2 is sufficient or not. (*Col. 4, Line 62 – Col. 5, Line 1*). If so, the fee for the service is withdrawn from the imaginary account 2. (*Col. 5, Lines 25-29*).

D. THE HARADA REFERENCE

Harada recites an interactive television system including a remote center apparatus 101, shown in Figure 1, a terminal apparatus 102, a display apparatus 102 and remote control apparatuses 104, 105 and 106. (*Col. 15, Line 35 – Col. 16, Line 6*). The center apparatus 101 communicates via a CATV network with a plurality of terminal apparatuses 102. (*Col. 16, Lines 36-39*). The terminal apparatus 102 supplies data to the display apparatus 103 and communicates with the remote control apparatuses 104, 105 and 106. (*Col. 16, Lines 39-47*). Each remote control apparatus 104, 105 and 106 is assigned a unique remote control identification number identifying a particular user and stores personal attribute information for the user. (*Col. 16, Lines 8-10 and Lines 20-25*). In addition, each terminal apparatus 102 is assigned a unique terminal identification number. (*Col. 16, Lines 11-13*). The center apparatus 101 stores the terminal identification number and associated remote control identification numbers. (*Col. 16, Lines 14-20*).

Each remote control apparatus 104, 105 and 106 can further be provided with user identification means, such as a password, fingerprint recognition or voice pattern recognition. (*Col. 7, Lines 14-22; Col. 24, Line 66 – Col. 25, Line 5; Col. 25, Lines 55-59; and Col. 26, Lines 15-17*). Before inputting message data to be sent to the center apparatus 101, the user first inputs the

necessary user-identification information to the remote control apparatus 104, 105 or 106, which compares the received user-identification information to stored user-identification information to authorize the user. (*Col. 25, Lines 5-11*). If the user is authorized, the user personal information and remote control apparatus identifier are read out and attached to a service request sent to the terminal apparatus 102, which in turn forwards the service request to the center apparatus 101. (*Col. 7, Lines 24-30; Col. 25, Lines 12-22*).

E. CLAIMS 5-11 and 13-16

For the reasons set forth below, the Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to Claims 5-11 and 13-16.

In rejecting Claims 5, 13 and 14, the Examiner stated: "It would have been obvious to one with ordinary skill in the art to include to Nakano et al bio-authentication information as the identification information because Harada et al teaches selectively controlling access (i.e. adults and children; col 4, lines 42-60). It would have been obvious to one with ordinary skill in the art to include to Nakano et al a bio-authentication device for providing the bio-authentication information as fingerprint sensor or voice sensor because Harada et al teaches authentication authorization." (October 8, 2003 Office Action, Page 4, Lines 7-14). The Appellant respectfully traverses the Examiner's assertions that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by *Nakano* to include elements of the device taught by *Harada*.

First, the supposed motivation to obtain “to selectively control access” is very general and does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The desire to “selectively control access” is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. *Nakano* does not disclose the concept of using bioauthentication information. *Harada* does not disclose the concept of a consumer electronics device having a local processor that operates in the manner as claimed by the Appellant. There is no suggestion or motivation to combine the teachings of the *Nakano* reference with the teachings of the *Harada* reference.

Second, the supposed motivation of “authentication authorization” is very general and does not specifically suggest combining the teachings of the *Nakano* reference with the teachings of the *Harada* reference. The fact that two references are concerned with the same general technical area does not without more provide a “clear and particular” motivation to combine the references. The Appellant respectfully submits that the alleged motivation to combine references has been assumed by “hindsight” in light of the existence of the Appellant’s invention.

Even if the *Nakano* reference could somehow be combined with the *Harada* reference, the combination would not teach, suggest, or even hint at the Appellant’s invention as set forth in Claims 5-11 and Claims 13-16. MPEP § 2142 indicates that a prior art reference (or references when two or more references are combined) must teach or suggest all the claim limitations of the

invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an Appellant's disclosure. In the present case, the *Nakano* reference and the *Harada* reference in combination would not teach or suggest all the claim limitations of the Appellant's invention.

The Appellants respectfully direct the Board's attention to exemplary Claim 5.

5. A consumer electronics device, comprising
a memory which stores account information for an account holder and sub-credit limits and bioauthentication information for authorized users of the account;
a bioauthentication device which provides bioauthentication information to the memory;
a communication link; and
a processor, which compares received bioauthentication information to stored bioauthentication information to detect a match, and finds an associated sub-credit limit corresponding to the received bioauthentication information, to enable a purchase over the response network via the communication network up to a maximum of the sub-credit limit, the processor sending the account holder information over the communication link only if the match is detected and the sub-credit limit is not exceeded. (Emphasis added).

The Examiner has not shown that the proposed combination of *Nakano* and *Harada* would teach or suggest all of the elements in Claim 5. The present invention comprises a local account authorization device in a consumer electronics device typically found in the home. In the present invention, the user sets up an account with sub-credit limits in a local consumer electronics device such as a set top box. The credit card information is not sent out on the network until after the bio-authentication information has been locally matched and the sub-credit limit has been locally determined. This element is not disclosed or suggested in the prior art.

The Examiner has stated that "Nakano et al discloses sending the account holder information

over the communication link only if the sub-credit limit is not exceeded (col 4, lines 65-67; col 5, lines 1-6).” (October 8, 2003 Office Action, Page 5, Lines 12-14). The Examiner has further stated that “It would have been obvious to one with ordinary skill in the art to modify Nakano et al. to include local sub-credit limit determination because Harada et al. teaches local determination of a user as important because personal information must be controlled (col. 3, lines 8-9) and since Nakano teaches credit sub-limits which is a type of personal information.” (December 1, 2003 Advisory Action, Page 2, Lines 7-9). The Appellant respectfully traverses these assertions.

Unlike the Appellant’s invention, the *Nakano* device sends a charge request from set top box 3 over a communications link to remote server/processor 1. The remotely located server/processor 1 makes the determination with respect to the sub-credit limit. In the Appellant’s device, the local processor in the consumer electronics device does not send account information over a communication link to a remote location until after the local processor has (1) locally matched the bio-authentication information, and (2) locally determined that the sub-credit limit has not been exceeded.

Harada does not cure the deficiencies of *Nakano*. Specifically, *Harada* does not teach or suggest sub-credit limits or making a determination with respect to the sub-credit limits. The Appellant respectfully submits that personal information does not teach sub-credit limits. However, even if the Examiner’s statement that credit sub-limits are a type of personal information is correct, the Examiner has not provided any teaching or suggestion in *Harada* of a determination with respect to the personal information. The remote control apparatus 104, 105 or 106 of *Harada* authorizes a

user based on user-identification information. No processing of the personal information at the remote control apparatus 104, 105 or 106 or terminal apparatus 102 is mentioned or suggested in *Harada*. Instead, the personal information is simply sent to the central apparatus 101 in a service request once the user is authorized. Therefore, the teachings of *Harada* are in effect similar to the teachings of *Nakano*. As a result, the Appellant respectfully submits that Claim 5 is patentable over the *Nakano* reference and the *Harada* reference, either separately or in combination.

The Appellant notes that Claims 6-11 depend directly or indirectly from Claim 5. As previously described, Claim 5 contains unique and novel claim limitations of the Appellant's invention. Therefore, Claims 6-11 also contain the same unique and novel claim limitations of Claim 5 and are therefore patentable over the *Nakano* reference and the *Harada* reference, either separately or in combination.

The Appellant notes that Claim 13 and Claim 14 contain elements that are analogous to the unique and novel elements of Claim 5 that have been previously discussed. The Appellant further notes that Claims 15-16 depend directly or indirectly from Claim 14. Therefore, Claims 15-16 also contain the same unique and novel claim limitations of Claim 14 and are therefore patentable over the *Nakano* reference and the *Harada* reference, either separately or in combination.

The Appellant therefore respectfully submits that Claims 5-11 and Claims 13-16 are in condition for allowance. Allowance of Claims 5-11 and Claims 13-16 is respectfully requested.

CONCLUSION

The Appellants have demonstrated that the present invention as claimed is clearly distinguishable over the prior art cited of record. Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Appellants have enclosed a check in the amount of \$330.00 to cover the cost of this Appeal Brief. The Appellants do not believe that any additional fees are due. However, the Commissioner is hereby authorized to charge any additional fees (including any extension of time fees) or credit any overpayments to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: March 5, 2004



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APPENDIX A

PENDING CLAIMS

1. (Canceled).
2. (Canceled).
3. (Canceled).
4. (Canceled).
5. (Previously presented) A consumer electronics device, comprising
a memory which stores account information for an account holder and sub-credit limits and
bioauthentication information for authorized users of the account;
a bioauthentication device which provides bioauthentication information to the memory;
a communication link; and
a processor, which compares received bioauthentication information to stored
bioauthentication information to detect a match, and finds an associated sub-credit limit
corresponding to the received bioauthentication information, to enable a purchase over the response
network via the communication network up to a maximum of the sub-credit limit, the processor
sending the account holder information over the communication link only if the match is detected
and the sub-credit limit is not exceeded.
6. (Original) The consumer electronics device as claimed in claim 5, wherein the
bioauthentication device is a fingerprint sensor.
7. (Original) The consumer electronics device as claimed in claim 6, wherein the
fingerprint sensor is located on a remote control for the consumer electronics device.

8. (Original) The consumer electronics device as claimed in claim 5, wherein the bioauthentication device is a voice sensor.

9. (Original) The consumer electronics device as claimed in claim 5, for receiving an advertisement and for causing the advertisement to be displayed, and wherein upon receipt of an authorized user's bioauthentication information the processor initiates a buy command to the advertiser through the communication network.

10. (Original) The consumer electronics device as claimed in claims 5, 6 or 7 wherein the consumer electronics device is a set top box.

11. (Original) The consumer electronics device as claimed in claims 5, 6 or 7 wherein the consumer electronics device is a television.

12. (Canceled).

13. (Previously presented) A device for locally controlling access to an account, comprising:

- a local storage device for storing account information of an account holder and sub-credit limits and bioauthentication information for authorized users of the account;

- a bioauthentication device for obtaining bioauthentication information from authorized users and an account holder;

- a processor for changing sub-credit limits on the storage device in response to a request from the account holder, provided the account holder has provided bioauthentication information which matches bioauthentication information stored on the local storage device for the account holder, and

- a communication network for authorizing a transaction on the account and sending the account holder's information in response to a request from an authorized user or account holder provided that the bioauthentication information provided by the authorized user or account holder matches the bioauthentication information of the authorized user or account holder stored on the local storage device and that the transaction does not exceed the sub-credit limit storage on the local storage device of the authorized user or account holder making the request.

14. (Previously presented) A consumer electronics device, comprising:

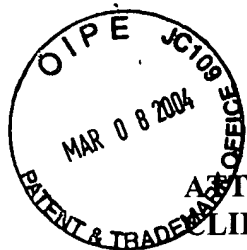
- a memory which stores a profile of a user, the profile indicates access levels of the user, and sub credit limits of authorized users of an account;
- a bioauthentication device which provides bioauthentication information to the memory;
- a communication link, and
- a processor, which compares received

bioauthentication information to stored bioauthentication information to detect a match, and detects the access levels of the profile associated with the matching bioauthentication information to determine whether requested access over the communication link can be given based on the received bioauthentication information, and whether the subcredit limit associated with the received bioauthentication information is enough to complete a requested transaction and sending the account holder information across the communication link only if there is a match and the subcredit limit it not exceeded.

15. (Original) The consumer electronics device as claimed is claim 14, wherein the memory also stores bioauthentication information of a profile maker, and wherein upon receipt of the profile maker's bioauthentication information the processor permits the profiles in the memory to be modified by the profile maker.

16. (Original) The consumer electronics device as claimed in claim 15, wherein the profile holds parental control information.

17. (Canceled).



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United States Serial No. : 09/734,808
Filed : December 12, 2000
Title : REMOTE CONTROL ACCOUNT AUTHORIZATION
SYSTEM
Art Group Unit : 3624
Examiner : Alain L. Bashore

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Commissioner for Patents
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CERTIFICATE OF MAILING BY FIRST CLASS MAIL

Sir:

The undersigned hereby certifies that the following documents:

1. Appeal Brief (in triplicate);
2. Fee Transmittal for FY 2004 (in duplicate);
3. Check in the amount of \$330.00 for the Appeal Brief filing fee; and
4. Two (2) postcard receipts;

relating to the above application, were deposited as "First Class Mail" with the United States Postal Service, addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 3, 2004.

Date: 3/5/04

Date: March 5, 2004

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